

## REMARKS

Claims 1 - 8 are in the case. All claims stand rejected. Claim 1 has been amended to state that the amount of rare earth metal is in the range of 40-55wt.%. Support for this amendment can be found in paragraph [0005] of the present application. No new matter has been added.

Claims 7 and 8 have been amended to state that they are processes utilizing the oxidic catalyst composition according to claim 1 and the catalyst particle according to claim 6, respectively. No new matter has been added.

## CLAIM REJECTIONS

### Rejection Under 35 U.S.C. 112 (Second Paragraph) and 35 U.S.C. 101

Claims 7 - 8 have been rejected under 35 U.S.C. 112, second paragraph, and 35 U.S.C. 101.

## EXAMINER'S POSITION

The Examiner takes the position that claims 7 and 8 are "use" claims and fails to recite any steps involved in the process

## APPLICANT'S POSITION

Claims 7 and 8 have been amended to state that they are processes utilizing the oxidic catalyst composition according to claim 1 and the catalyst particle according to claim 6, respectively. Applicants respectfully point the Examiner to MPEP 2173.05:

In the case of *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992), the Board held that a claim which clearly recited the step of "utilizing" was not indefinite under 35 U.S.C. 112, second paragraph. (Claim was to "A method for unloading nonpacked, nonbridging and packed, bridging flowable particle catalyst and bead material from the opened end of a reactor tube which comprises utilizing the nozzle of claim 7.").

Thus, Applicants take the position that claims 7 and 8 are proper. The Examiner is requested to reconsider and withdraw these rejections.

REJECTION UNDER 35 U.S.C. 103(a)

Claims 1 - 3 and 5 - 6 have been rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent Number 5,364,516, Kumar, et al. ("Kumar").

**FIRST REJECTION UNDER 35 U.S.C. 103**

Claims 1-3 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar.

**EXAMINER'S POSITION**

The Examiner takes the position that each and every range of each individual component of the composition taught by Kumar overlap with the corresponding weight percentage range of each individual component of instant claim 1.

**APPLICANTS' POSITION**

Applicants respectfully disagree with the Examiner, and Applicants take the position that the present invention is not obvious in light of the teachings of Kumar. Claim 1 has been amended to state that the amount of rare earth metal is in the range of 40-55wt.%. Thus, the limitations of the present invention do not overlap with Kumar.

The Examiner is requested to reconsider and withdraw this rejection.

**SECOND REJECTION UNDER 35 U.S.C. 103**

Claim 5 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar.

**EXAMINER'S POSITION**

The Examiner takes the position that Kumar teaches a process similar to that claimed in claim 5, pointing to column 2, lines 48-63 of Kumar.

**APPLICANTS' POSITION**

Applicants respectfully disagree with the Examiner, and Applicants take the position that the invention of claim 5 is not obvious in light of the teachings of Kumar. Claim 5 relates to a process involving the calcination of a physical mixture (*emphasis added*) of a divalent, a trivalent, and a rare earth metal source. To the contrary, Kumar teaches making a slurry, spray drying the slurry, and calcining the spray dried particles recovered from the

slurry. Thus, Kumar does not teach the calcination of a physical mixture of a divalent, a trivalent, and a rare earth metal source, as is presently claimed.

The Examiner is requested to reconsider and withdraw this rejection.

### **THIRD REJECTION UNDER 35 U.S.C. 103**

Claim 6 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar.

#### **EXAMINER'S POSITION**

The Examiner takes the position that Kumar teaches a catalyst particle similar to that claimed in claim 6, pointing to column 2, lines 27-30 of Kumar.

#### **APPLICANTS' POSITION**

Applicants respectfully disagree with the Examiner, and Applicants take the position that the invention of claim 6 is not obvious in light of the teachings of Kumar. Claim 6 relates to a catalyst particle comprising the oxidic catalyst composition according to claim 1, a matrix or filler and a molecular sieve. Kumar neither teaches nor suggests the oxidic catalyst composition according to claim 1 for the reasons noted above. Thus, Kumar neither teaches nor suggests the catalyst particles of claim 6.

The Examiner is requested to reconsider and withdraw this rejection.

### **FOURTH REJECTION UNDER 35 U.S.C. 103**

Claim 4 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar in further view of European Patent Application 0554968 to Kim ("Kim").

#### **EXAMINER'S POSITION**

The Examiner takes the position that Kumar teaches a method of making obvious variant of the composition of instant claim 1 involving calcining a physical mixture of a divalent, trivalent and a rare earth metal source. The Examiner notes, however, that Kumar does not explicitly teach forming a precipitate from a solution containing dissolved divalent, trivalent, and rare earth metal salts followed by calcinations of the precipitate obtained.

Thus, the Examiner has cited Kim for preparing a magnesia-lanthana-alumina composition by calcining a precipitate of a solution of lanthanum nitrate, sodium aluminate, and magnesium nitrate.

## APPLICANTS' POSITION

Applicants respectfully disagree with the Examiner, and Applicants take the position that the invention of claim 4 is not obvious in light of the teachings of Kumar in view of Kim.

As noted above, Kumar does not provide support for calcining a physical mixture of a divalent, trivalent and a rare earth metal source.

With regards to the examiner's combination of Kim and Kumar, Applicants take the position that this combination is improper. The Examiner merely makes a blanket statement that this would be obvious because these two methods are known in the art. However, the Examiner appears to ignore the entire teaching of Kumar that the slurry that is spray dried contains acid reacted metakaolin, a zeolite/molecular sieve component, and an aluminum sol matrix. Kumar teaches that these components are combined with finely divided rare-earth oxalate and optionally calcium and/or magnesium oxide and spray dried. It neither suggests nor teaches that any of these components can be precipitated from a solution, but teaches that these components are formed into a slurry.

Applicants submit that the prior art is replete with disclosures of precipitating materials from solutions. However, to combine these teachings with references that do not provide even a hint that the processes used within these references can be operated via precipitation nor would precipitation methods produce materials falling within the limitations of the inventions within these references is incorrect.

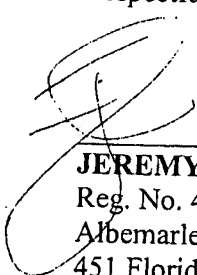
Further, it is well settled that references must be taken as a whole. The Examiner appears to ignore the aging steps, pH adjustment steps, etc., required in the teachings of Kim, see page 3 of Kim.

While the Examiner points Applicants to MPRP 2144.06 regarding substituting equivalents, Applicants respectfully submit that producing a material from a slurry and precipitating a wholly different material from a solution are two completely different processes and are not equivalents. Applicants respectfully submit that a reference that teaches that an acid reacted metakaolin, a zeolite molecular sieve, and an acid aluminum sol are combined with finely divided rare-earth oxalate and optionally calcium and/or magnesium oxide and spray dried is not the equivalent of precipitating from a solution containing the same.

The Examiner is requested to reconsider and withdraw this rejection.

Based on the preceding amendments and remarks, the Examiner is requested to withdraw all objections, reconsider and withdraw all rejections, and pass this application to allowance. The Examiner is encouraged to contact Applicants' attorney should the Examiner wish to discuss this application further.

Respectfully submitted,



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